

## **REMARKS**

### **1. Status of Claims**

Claims 1-17 were pending in the Application. Applicants have amended claims 1-2, 4-5 and 8-11 without prejudice or disclaimer. Applicants have added new claims 18-20. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-20 will remain pending in the application.

### **2. Telephonic Interview**

Applicants thank Primary Examiner Dang and Supervisory Primary Examiner Rinehart for the courtesy of the July 16, 2008 Telephonic Interview.

Applicants noted that the application had been on appeal for quite some time with a first brief filed more than three years ago in June 2005. Applicants contend that the Answer improperly raised new rejections and improperly relied on alleged Official Notice and newly cited alleged prior art that was not available against the instant application as more fully described in the September 23, 2005 Reply brief. On November 16, 2007 the BPAI vacated the Examiner's Answer and did not appear to indicate confusion. Applicants respectfully submit that the April 2, 2008 Final Office Action was improperly issued as a final action and thank the Examiner for vacating the finality of the action.

Applicants reiterate that the April 2, 2008 PTO-892 does not establish that the three cited alleged prior art references are available as prior art. Two items are undated and clearly not available as prior art in this case. One item includes only a copyright notice, but no indication that the reference was available to those of skill in the art at a sufficiently early date. Copyright notices do not prove a date of "publication" or "retrieval" and are often "carried forward" on a later version of a document as content is updated. Therefore, the copyright notice does not establish that the item cited is available as published or available for retrieval. See e.g., MPEP 2128. Accordingly, none of the April 2, 2008 PTO-892 items U, V, and W are available as prior art in this case.

Moreover, Applicants maintain that the statements of Official Notice in this case have been properly and repeatedly disputed with corresponding references requested. Applicants have asserted a good faith dispute regarding the statements of Official Notice (except as to only those expressly stated as not disputed in the Reply Brief) and respectfully submit that the Examiner must then support such statements using prior art references available against the instant application.

### **3. Rejections under 35 USC § 112**

On page 2 of the Office Action, the Examiner rejected claims 8 and 10 under 35 U.S.C. 112, second paragraph as allegedly indefinite. The Examiner states that the claim term “sending an email using a physical address of a recipient is unclear.” The Examiner apparently further took the position during the July 16, 2008 telephone interview that he believed an electronic e-mail address must necessarily be used.

Applicants respectfully traverse the rejection. With reference to the “pull” e-mail architecture described in the specification for example with reference to FIG. 5, it is clear that only a physical address could be used in an illustrative embodiment to determine the e-mail mailbox used. The recipient then logs in to the central e-mail server to pull his e-mail after logging in without ever using the traditional “@” e-mail addresses. Of course, such a claim limitation is not intended to exclude a traditional e-mail address.

Moreover, such interpretation is supported by paragraph 0038 where a “traditional e-mail address” is distinguished as an alternative embodiment used for routing an e-mail to another e-mail account such as HOTMAIL, etc. that necessarily requires the traditional “@” formatted e-mail addresses. Accordingly, Applicants respectfully dispute the Examiner’s interpretation and thus traverse the rejection. One of skill in the art would read the specification with reference to the figures and understand the use of a physical address to send the e-mails as described and as presently claimed.

New claims 18-20 further differentiate the alternative use of traditional e-mail addresses.

Additionally, Applicants have amended claims 8 and 10 without prejudice or disclaimer. Claim 8 has been amended to recite receiving the e-mail as shown and claim 10 has been amended to recite a physical mailing address as described more fully below.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

#### **4. Rejections under 35 USC § 103**

On page 3 of the Office Action, the Examiner rejected claims 1-6, 11, 13, 14, 16, and 17 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") (sic, and in view of alleged Official Notice).

Applicants respectfully traverse the rejection.

Initially, it is unclear how the Examiner is interpreting the phrase "physical address" and clarification is requested. The term "physical address" clearly means an address of a location such that a mail carrier uses to locate a home, business, etc. Such usage is the common usage of the term and the Examiner has not pointed to any evidence suggesting the contrary. Applicants have amended the term physical address to further expressly state the clearly intended meaning for cosmetic purposes to now recite "physical mailing address" although such is understood from common usage and the specification. See for example, the U.S. Domestic Mail Manual DMM at 508 as illustrative examples of the use of the phrase.<sup>1</sup> Applicants traverse the rejection. If the Examiner does not agree that the amendment regarding the term "physical mailing address" is merely cosmetic, Applicants request that those amendments not be entered and reserve the right to reverse the amendment to use the original term "physical address." Applicants expressly state that the amendments adding the term "mailing" are not for purposes of addressing patentability concerns and are merely for cosmetic purposes. No change in scope or lexicography is intended.

Moreover, the specification supports such an interpretation of physical mailing address in at least three places. The illustrative example in paragraphs 0032-32 describe printing and delivering the e-mail using traditional mail that requires a physical

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<sup>1</sup> <http://pe.usps.gov/cplm/ftp/manuals/dmm300/508.pdf>,

mailing address. The illustrative USPS CASS systems described in paragraph 0023 necessarily utilize physical mailing addresses. Even the illustrative fictitious North Pole address, while obviously used only for illustration purposes and not intended to refer to an actual true address, includes a physical mailing address "123 North Pole Lane."

The Examiner has not pointed to any evidence that supports a different interpretation.

Next, Applicants dispute the statement of Official Notice and also dispute any combination with Hogan. Applicants dispute that mapping a physical address to an email address is old and well known and again request a reference. Applicants dispute that the "Infospace" reference is available as prior art. Applicants also dispute that the "Infospace" reference establishes a physical address since it refers at best to only a City/State/Country designation. As an example, a person named Smith will come up with multiple hits in the city and thus such a system cannot be used as an address system. Applicants are not required to prove that something does not exist in the prior art. Applicants have provided detailed reasoned arguments refuting the statements of Official Notice, the motivation to combine them and the sufficiency of them to provide a prima facie obviousness rejection. In this case, Applicants on at least two prior occasions have provided reasoned arguments disputing the statements of Official Notice. See MPEP 2144.03.

The taking of Official Notice is a device for convenience and not meant to remove the requirement of establishing a prima facie rejection. Applicants respectfully request clearly defined statements of Official Notice. Furthermore, mapping said physical address of said recipient to an e-mail address of said recipient is significant as at least one clear points of novelty for which the Examiner is relying solely upon alleged common knowledge as the principal evidence upon which the rejection is based. As discussed in *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ 2d 1693, 1697 (Fed. Cir. 2001), such reliance on common knowledge is never appropriate. *See also*, *In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002).

Furthermore, with regard to independent claim 1 and dependent claim 13, Hogan '528 does not describe or suggest at least an electronic mailbox as presently claimed.

With regard to independent claim 5, Hogan '528 does not describe such physical address input or mapping function as presently claimed.

Moreover, with reference to dependent claims 2-4 and 16, Hogan '528 does not appear to describe or suggest the physical delivery systems as presently claimed and only appears to suggest alternative regular mail delivery after a timeout at Col. 10, lines 9-12.

Further, dependent claim 6 recites "routing an e-mail to a printer where the e-mail is printed and delivered via traditional mail delivery means." Hogan does not disclose printing an e-mail and delivering it via traditional mail.

With regard to the "The Ultimate Email Director" reference, Applicants dispute that it is available as prior art. Moreover, there is nothing there to suggest that mapping that the Examiner asserts is taken by Official Notice maps to a physical address (specifically Infospace describes only City/State/Country).

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

On page 9 of the Office Action, the Examiner rejected claim 7 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of U.S. Patent No. 6,343,327 B2 to Daniels, Jr., et al. ("Daniels '327") (sic, and in view of alleged Official Notice).

Applicants respectfully traverse the rejection.

Initially, dependent claim 7 is patentable over the cited references for at least the same reasons described herein with reference to the associated independent claim and any intervening claims. Claim 7 recites the e-mail is associated with one of a plurality of classes. This is also not taught by Hogan.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

On page 10 of the Office Action, the Examiner rejected claims 8 and 9 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of U.S. Patent No. 6,343,327 B2 to Daniels, Jr., et al. ("Daniels '327") (sic, and in view of alleged Official Notice).

Applicants respectfully traverse the rejection.

Applicants dispute the statement of Official Notice regarding "mapping a physical address to an email address" and also dispute any combination with Hogan. Applicants disagree with the rejection for at least the reasons described above, especially with reference to similar elements recited in claim 1. Furthermore, independent claims 8 and 9 recite:

8. A method for routing e-mail, comprising the following steps:  
receiving an e-mail addressed using a physical address of a recipient, wherein said e-mail has a designator tag that associates said e-mail with one or a plurality of classes of service;  
performing a mapping function on a server upon receipt of said e-mail, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient;  
specifying said classes for which said recipient desires to receive a physical mailpiece and said classes for which said recipient desires to receive an actual copy of the e-mail in a mail control file;  
storing the e-mail in an electronic mailbox of said recipient; and  
if said recipient chooses to receive physical mail, then routing the e-mail to a printer where the e-mail is printed, delivering the e-mail via traditional mail delivery means, and electronically notifying said recipient and sender that a physical copy of the e-mail was sent to said recipient.

9. A system for routing e-mails, comprising:  
a server that includes a database, said database including a mapping from a physical mailing address to an e-mail address, wherein said server is connected to a network, said server further including an electronic mailbox for each physical mailing address, wherein  
said electronic mailbox is associated with an account number and password, wherein said server includes a mail control file containing E-designators, said E-designators representing classes of service; and  
a recipient host, said host being able to access e-mails on said server using said account number and said password. (emphasis added).

The cited references do not teach or suggest in proper combination at least the emphasized recitations. Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

On page 13 of the Office Action, the Examiner rejected claim 12 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of alleged Official Notice.

Applicants respectfully traverse the rejection.

Initially, dependent claim 12 is patentable over the cited references for at least the same reasons described herein with reference to the associated independent claim and any intervening claims.

With regard to "tagging an email as time sensitive". Official Notice is not disputed. Appellants do not concede that the combination is appropriate and submit that the claim is patentable for at least the stated reasons with reference to independent claim 1 and also dependent claim 11.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

On page 15 of the Office Action, the Examiner rejected claim 15 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of alleged Official Notice.

Applicants respectfully traverse the rejection.

Applicants again note that for example that Baird III, et al. (6,732,278) is not available as prior art.

Applicants again request a clear statement of Official Notice. Applicants dispute any statement of Official Notice beyond "biometric data" generally being known. To the extent that it is only biometric data that is claimed as old and well known, such statement would not be disputed. However, the rejection is unclear. To the extent that Baird is cited, it is not available as prior art. Furthermore, the Examiner has not pointed to anything in it that suggests the more expansive statement that the use of biometric data to access email was old and well known before the effective filing date of the

present application. Applicants do not concede that the combination is appropriate and submit that the claim is patentable for at least the prior stated reasons.

Initially, dependent claim 15 is patentable over the cited references for at least the same reasons described herein with reference to the associated independent claim and any intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

On page 17 of the Office Action, the Examiner rejected claims 5 and 13 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 5,944,787 to Zoken ("Zoken '787") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Applicants respectfully traverse the rejection.

Here, the Examiner admits that the elements directed to mapping the physical address of a recipient to an email address of a recipient are not disclosed. The statement of Official Notice is disputed for the same reasons described above with reference to "mapping a physical address to an email address". A reference is requested.

Regarding claim 5, the cited references do not teach or fairly suggest at least the mapping function:

5. A method for routing e-mail, comprising the following steps:  
allowing a user to specify a physical mailing address of a recipient to whom the e-mail is to be sent; and  
performing a mapping function on a server, said mapping function mapping said physical mailing address of said recipient to an e-mail address of said recipient. (emphasis added).

Zoken, like Hogan, fails to teach or suggest mapping a physical address of a recipient to an e-mail address as admitted by the Examiner. There is simply no motivation within Zoken to make such a modification to the system of Zoken. The Examiner is merely using impermissible hindsight.

The Examiner has failed to establish a prima facie case for an obviousness rejection.



Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

Applicants dispute each statement of Official notice and request a reference except to the extent Applicants expressly stated herein that a particular limited statement of Official Notice was not disputed. Not disputing a particular statement of Official notice is not acquiescing to any combination with other references.

On page 18 of the Office Action, the Examiner rejected claim 10 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,015,167 to Savino, et al. ("Savino '167") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Applicants respectfully traverse the rejection.

Here, the Examiner admits that the elements directed to mapping the physical address of a recipient to an email address of a recipient are not disclosed. The statement of Official Notice regarding "mapping a physical address to an email address" is disputed for the same reasons described above with reference to.

Independent Claim 10 recites:

10. A method for parcel delivery notification, comprising the following steps:

- (a) receiving an electronic order for a parcel;
- (b) generating a parcel barcode;
- (c) scanning a parcel barcode;
- (d) sending an e-mail to a buyer who placed said electronic order by e-mail, wherein a physical mailing address of said buyer is used to send said e-mail, said step (d) occurring upon executing said scanning step (c);
- (e) shipping the parcel to a parcel delivery center;
- (f) scanning the parcel barcode at said parcel delivery center; and
- (g) electronically notifying said buyer who placed said electronic order by e-mail, wherein said physical mailing address of said buyer is used to send said e-mail, said step (g) occurring upon executing said step (f). (emphasis added).

With regard to "sending email notification to a buyer after an on-line purchase is a common practice in e-commerce." To the extent that it is only that statement taken as old and well known, such statement would not be disputed. However, the rejection is

unclear. Appellants do not concede that the combination is appropriate and submit that the claim is patentable for at least the prior stated reasons.

As discussed above with at least reference to claim 1, the invention as claimed allows a physical address of a recipient to be used to send an e-mail. Independent claim 10 clearly recites this feature. The Savino patent fails to teach or suggest at least this feature. Furthermore, the Examiner alleges that it was well known to send an e-mail notification to a buyer after an on-line purchase, but not that an e-mail be sent to a purchaser using his/her physical address as recited in claim 10.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

New Claims 18-20 are patentable over the cited references for at least the reasons described above.

Accordingly, Applicants respectfully submit that claims 1-20 are in condition for allowance and respectfully request that the Examiner withdraw the rejections.

#### **5. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

The Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

#### **6. Authorization**

No fee is believed due with this response other than that submitted with any associated petition for extension of time. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-906-O1.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for

that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-906-O1.

Respectfully submitted,

/George M. Macdonald/

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